REMARKS

Claims 1-24 are currently pending in the application. Reconsideration and allowance of the pending claims are respectfully requested in light of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. §103

Claims 1-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,270,946 to Shibasaki et al ("Shibasaki") in view of U.S. Patent No. 5,336,568 to Andrieu ("Andrieu"). Applicants respectfully traverse the Examiner's position for the following reasons.

As the PTO recognizes in MPEP §2142:

> ... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

1. Even when combined, the references do not teach the claimed subject matter.

The cited references cannot be applied to reject independent claims 1, 13 and 24 under 35 U.S.C. §103(a) because, even when combined, the references do not produce the claimed subject matter.

Claim 1, as amended, recites, in part:

> wherein at no time during operation are both the first and second batteries connected for supplying current.

The Examiner acknowledges that Shibasaki fails to teach "switching circuit for repeatedly switching between the first battery and the second battery, each battery supplying a peak amount of current for periods of time during which the switching circuit has connected one of the batteries for supplying current, while, simultaneously, the other of the batteries supplies no current whereby, in the aggregate, the batteries maintain a continuous supply of beak [sic] current to the system," for which Andrieu is cited. However, in the system taught by Andrieu, there are periods of time (e.g., Fig. 3, intervals t2, t4, and t6) during which both battery cells 20, 21, are connected to the load (*see* column 4, lines 44-60). This is clearly not the same as "at no

time during operation are both the first and second batteries connected for supplying current", as recited in claim 1. Clearly, therefore, the combination of references fails to teach, suggest, or render obvious all of the limitations of claim 1.

In view of the foregoing, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection of claim 1, as well as claims 2-12 dependent therefrom, under 35 U.S.C. §103 should be withdrawn and those claims allowed.

Claims 13-23 include limitations similar to those of claims 1-12; therefore, for at least the same reasons as set forth above with reference to claim 1, the rejection of claims 13-23 under 35 U.S.C. §103 should be withdrawn and those claims allowed. Claim 24 includes limitations similar to those of claim 1; therefore, for at least the same reasons as set forth above with reference to claim 1, the rejection of claim 24 should be withdrawn and the claim allowed.

2. The combination of references is improper.

Assuming, *arguendo*, that when combined, the references teach the claimed subject matter (which is clearly not the case, as demonstrated above), there is another, mutually exclusive, and compelling reason why the references cannot be applied to reject the claims under 35 U.S.C. §103.

§2142 of the MPEP also provides:

> ... The examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.... The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither Shibasaki nor Andrieu teaches or even suggests the desirability of combining elements of a apparatus for controlling selection of batteries, as taught by Shibasaki, with a device for optimizing the discharge of at least two electrochemical cells, as taught by Andrieu. Clearly, neither reference provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection of any of the independent claims.

The MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In this context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the independent claims. Therefore, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Conclusion

For at least the reasons set forth in detail above, independent claims 1, 13 and 24 are deemed to be in condition for allowance. Claims 2-12 and 14-23 depend from and further limit independent claims 1 and 13 and are therefore also deemed to be in condition for allowance. Accordingly, Applicants respectfully request that the Examiner withdraw the pending rejections and issue a formal notice of allowance.

Respectfully submitted,

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